



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,704	11/09/1999	DANIEL R. BAUM	SF003001 (11087-004001)	7040
7590	09/21/2006		EXAMINER	
Shulterfly, Inc C/O Xin Wen 2800 Bridge Parkway Redwood City, CA 94065			BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
				2625

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

09436704

EXAMINER
----------

ART UNIT	PAPER
----------	-------

20060911

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/436,704

SEP 21 2006

Filing Date: November 09, 1999

Appellant(s): BAUM, DANIEL R.

**Technology Center 2600**

---

Bao Tran  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/15/04 appealing  
from the Office action mailed 8/26/04.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,872,706	BREWEN et al	10-1989
5,056,823	STANCATO	10-1991
5,555,496	TACKBARRY et al	9-1996
5,652,936	KLEES et al	7-1997
5,666,215	FREDLUND et al	9-1997
6,157,436	COK	12-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims (see 8/26/04 Office Action) :

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154

Art Unit: 2625

are rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al.

Re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, Fredlund et al discloses (Abstract; column 2, lines 28-42; column 5, lines 32-51; column 6, lines 30-42; column 7, lines 18-30; Figure 1B) a computer-implemented method and print system in which a user may select a series of images to be photographically printed and respectively sent to a recipient address by a single entity (a photo processing station: see column 6, lines 17-42).

Further re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, while Fredlund et al describes the set of images selected to be sent to one recipient as an "order", a sequence in which one set of images is designated for printing and sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for printing and sending to a different recipient (and so on until all desired images and recipients are selected) is readable upon Applicant's use of the term "order specifying a plurality of recipients" (which would then consist of several "sub-orders", each being sent to a given recipient), inasmuch as the present claim

Art Unit: 2625

language does not preclude the reading of such a multi-recipient session upon the term "order" as used in the present claims.

Further re claims 80-81, 86-87, 91-92, 94-96, & 107-110, a front-end computer subsystem (Figure 1B, item 26; column 4, line 37 - column 6, line 45, particularly column 4, lines 37-45 & column 6, lines 16-41) receives orders sent by users for particular pictures to be sent to particular recipients, a printing subsystem (Figure 1B, items 104 & 106; column 7, lines 18-31) prints copies of ordered images, and a distribution subsystem (Figure 1B, items 25, 27, & 29; column 8, lines 12-15) generates address labels and instructions for distributing the resulting prints to the customer.

Further re claims 3-6, 22, 44, 48, 51, 57-58, 63, 82-85, 140, & 144-146, Fredlund et al discloses (column 7, lines 60-64) the computer-aided customization of image print parameters (including a text message) for individual images to be sent to respective recipients.

Further re claim 10, 67, 89, & 154, Fredlund et al discloses (Figure 3; column 5, lines 14-16) the provision of a front-end graphical user interface that is used to present information and collect user inputs to be remotely transmitted.

Further re claims 18-21, 71-74, 97-99, & 136-139, Fredlund et al discloses (column 8, lines 12-15) the printing of an

Art Unit: 2625

address label (inherently including the recipient's name and address, as the absence of this information would make the "address label" fail in the purpose of indicating a destination address).

Further re claims 23-24, 45, 100-101, & 141-142, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an ordered image in the form of a Photo CD (a medium containing one or more digital image files).

Further re claims 34 & 111, the specified recipient differs from the customer in any case in which the customer enters any address other than his own as a recipient address area 70 (column 6, lines 23-25).

Further re claims 35-38 & 112-115, the sequence in which one set of images is designated for sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for sending to a different recipient (and so on until all desired images and recipients are selected) comprises at least one charge (which is readable upon a recitation of "a single charge" unaccompanied by limitations precluding a plurality of charges) to a financial instrument (column 6, lines 30-41) such as a credit card (column 6, lines 45-46). The sequence is terminated (in the case where the user

Art Unit: 2625

wishes to go ahead with the planned order) by pressing a "send" button to place the order (column 6, lines 53-54).

Further re claim 42, Fredlund et al discloses (column 7, lines 60-64) the printing of an image to be sent to a designated recipient in the form of a framed print.

Further re claims 46-47, Fredlund et al discloses (column 7, lines 49-51) the printing of an image upon a novelty item such as a customized coffee mug or T-shirt.

Further re claims 49-50, Fredlund et al discloses (Figure 3) the printing of an image upon a card (3x5, 4x6, etc).

Further re claim 52, the text message of Fredlund et al (column 7, lines 60-64) is readable upon the recited "advertisement" in the case where the user enters an advertising statement as the selected text.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 2625

4. Claims 9, 11, 14, 66, 68, 70, 88, 90, & 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Tackbarry et al.

Re claims 9, 11, 14, 66, 68, 70, 88, 90, & 93, Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 2 supra (i.e. by a single entity).

Fredlund et al does not disclose expressly the division of these steps among separate entities.

Tackbarry et al discloses (column 12, line 55 - column 13, line 3) an order receiving, printing, and distribution process for picture prints in which the distribution process is carried out by an entity different from the entity that receives and prints orders.

Fredlund et al and Tackbarry et al are combinable because they are from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Tackbarry et al system of print distribution.

The suggestion/motivation for doing so would have been allow the use of established distribution channels (such as those taught by Tackbarry et al at column 9, lines 9-11).

Art Unit: 2625

Therefore, it would have been obvious to combine Fredlund et al with Tackbarry et al to obtain the invention as specified in claims 9, 11, 14, 66, 68, 70, 88, 90, & 93.

5. Claims 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Cok.

Re claims 25-27, 75-77, 102-104, 116-118, 121-126, 150-151, & 153, Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 2 supra.

Re claims 28, 78, 105, 119, & 151, Fredlund et al further discloses (column 3, lines 19-42) the provision of photo prints via a photo store, supermarket, or drugstore.

Re claims 29, 79, 106, 120, & 155, in the case in which a user purchases prints from such a provider and also orders other goods and services provided therefrom, the two will be distributed via the same channel.

Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the printing of the order.

Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor)

and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9).

Therefore, it would have been obvious to combine Fredlund et al with Cok to obtain the invention as specified in claims 25-29 & 75-79.

6. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Brewen.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 2 supra.

Fredlund et al does not disclose expressly a picture print in the form of a coupon.

Brewen discloses (Figure 3) the production of a picture print in the form of a coupon.

Fredlund et al and Brewen are combinable because they are both from the field of digital image selection and printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print a picture whose content is that of the coupon disclosed by Brewen.

The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a specific type of desired image printout.

Therefore, it would have been obvious to combine Fredlund et al with Brewen to obtain the invention as specified in claim 53.

7. Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Stancato.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 2 supra.

Fredlund et al does not disclose expressly the binding of picture prints in the form of a bound volume such as an album or travel book.

Stancato discloses (column 1, lines 6-16) the production of a bound volume of picture prints (which inherently constitutes a "photo-album", and constitutes a "travel book" in the case where the user selects images for the purpose of documenting and illustrating travel).

Fredlund et al and Stancato are combinable because they are from the field of digital image selection and printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print pictures which are bound in the volume described by Stancato.

The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a set of images that are bound for protection and convenient access.

Therefore, it would have been obvious to combine Fredlund et al with Stancato to obtain the invention as specified in claims 54-56.

Art Unit: 2625

8. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al.

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 2 supra.

Fredlund et al does not disclose expressly that the computer system used for order input is a public entry terminal.

Klees et al discloses (column 2, line 29 - column 3, line 4; particularly column 2, lines 53-57) the use of a publicly accessible terminal to enter a picture print order.

Fredlund et al and Klees et al are combinable because they are both from the field of order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a publicly accessible terminal to accept orders into the Fredlund et al system of order receiving, printing, and distributing process of picture prints.

The suggestion/motivation for doing so would have been so that customers who do not possess individual personal computers may be served.

Therefore, it would have been obvious to combine Fredlund et al with Klees et al to obtain the invention as specified in claim 62.

9. Claims 127-131 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al as applied to claim 62 above, and further in view of Cok.

Re claims 127-131, Fredlund et al in view of Klees et al teaches the order receiving, printing, and distributing process of picture prints, with the order receiving implemented through a public terminal kiosk, as described in the previous paragraph.

Further re claims 128-129, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an ordered image in the form of a Photo CD (a computer-readable medium containing one or more digital image files).

Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the photo printing of the order.

Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor) and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9).

Therefore, it would have been obvious to combine Fredlund et al in view of Klees with Cok to obtain the invention as specified in claims 127-131.

**(10) Response to Argument**

Appellant argues (10/15/04 Appeal Brief: page 11, line 31 - page 13, line 23) that Fredlund fails to show the claimed order specifying a plurality of recipients with a set of one or more images associated with that recipient.

However, as set forth in the outstanding Grounds of Rejection, the term "order" as used in the present claims is read upon a multi-recipient ordering sequence comprising a batch of several "orders" as that term is used in Fredlund (column 6,

lines 30-33), each "order" consisting of a plurality of images sent to a particular recipient.

Re this reading, Appellant argues (10/15/04 Appeal Brief: page 12, lines 3-13) that it is inconsistent and (10/15/04 Appeal Brief: page 12, lines 14-17) that it relies upon hindsight reasoning.

Re the argument that the reading is inconsistent, it is noted that an "order" as that term is used in the present claims is being read upon a batch of several "orders" as that term is used in Fredlund. However, this difference in usage does not render the reading inconsistent, so long as it is understood that the term has one meaning in the context of the present claims and a different meaning in the context of Fredlund, both the present Appellant and Fredlund each being their own lexicographer in their respective disclosures and claims.

Re the argument that the reading relies upon hindsight, it must be recognized that any judgment is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues (10/15/04 Appeal Brief: page 13, line 24 - page 15, line 4) that dependent claims 2-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154 are allowable because they depend from allowable parent claims and because claimed specifics with respect to these claims are missing.

Re the argument that these claims are allowable because they depend from allowable parent claims, Appellant's arguments for the allowability of these parent claims have been addressed above.

Re the argument that claimed specifics with respect to these claims are missing, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Specifically, Appellant's arguments consist of a series of assertions in the form "Fredlund does not show an order with a plurality of recipients where [additional feature(s) of dependent claim]." The question of whether Fredlund shows an order with a plurality of recipients has been addressed above. The question of whether Fredlund discloses the recited additional features of the

various dependent claims is not discussed by Appellant beyond the offering of these assertions.

Appellant argues (10/15/04 Appeal Brief: page 16, line 25) that claims 9, 11, 14, 66, 68, 70, 88, & 90 are allowable because they depend from allowable parent claims.

Re the argument that these claims are allowable because they depend from allowable parent claims, Appellant's arguments for the allowability of these parent claims have been addressed above.

Appellant argues (10/15/04 Appeal Brief: page 16, lines 26-31) that the art of record does not disclose the claimed combination of elements (e.g. the receiving, printing, and distributing of orders with multiple recipients dispersed among two or more different entities).

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues (10/15/04 Appeal Brief: page 16, line 32 - page 18, line 19 and page 19, line 9 - page 20, line 20) that the Tackbarry reference fails to provide a suggestion or

Art Unit: 2625

motivation to modify the teachings of Fredlund, and that the combination of references as set forth in the outstanding rejection is based upon hindsight reasoning.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of established distribution channels is part of the knowledge generally available to one of ordinary skill in the art.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 2625

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues (10/15/04 Appeal Brief: page 18, line 20 - page 19, line 8) that there was no reasonable expectation of success when combining "the Johnson catalog for standardized products with the Fredlund unique image system" (page 18, lines 21-22).

The reference to "the Johnson catalog" appears to pertain to a rejection (10/28/03 Final Rejection) that is no longer pending, having been superceded by the rejection made upon reopening of prosecution in the 8/26/04 Office Action. (Examiner infers that this and other references to "Johnson" later in the Appeal Brief are intended to pertain to the reference cited in the outstanding rejection of the claims under discussion.)

Appellant has not offered any reasoning or evidence to support an assertion that the combination of Fredlund et al and Tackbarry described in the currently outstanding rejection (i.e. that it would be obvious to one of ordinary skill in the art to have the Fredlund et al distribution process is carried out by an entity different from the entity that receives and prints orders, as is done by the Tackbarry picture ordering and distributing system) lacks reasonable expectation of success.

Appellant argues (10/15/04 Appeal Brief: page 22, line 14) that claim 53 is allowable because it depends from an allowable parent claim.

Re the argument that this claim is allowable because it depends from an allowable parent claim, Appellant's arguments for the allowability of this parent claim have been addressed above.

Appellant argues (10/15/04 Appeal Brief: page 22, lines 15-23) that the Office Action fails to show any evidence in Brewen or knowledge of those skilled in the art to provide a suggestion or motivation to modify the Fredlund reference so as to produce the claimed invention, and that the combination of references as set forth in the outstanding rejection is based upon hindsight reasoning.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Art Unit: 2625

Cir. 1992). In this case, the use of a disclosed arrangement for receiving an order to print a picture, printing a picture, and distributing the picture (as taught in Fredlund) for the purpose of printing a specific picture of a known type (e.g. the coupon image of Brewen) is knowledge generally available to one of ordinary skill in the art.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues (10/15/04 Appeal Brief: page 23, lines 16-22 & 24-33) that the Office Action fails to show any evidence in Stancato or knowledge of those skilled in the art to provide a suggestion or motivation to modify the Fredlund reference so as to produce the claimed invention, and that the combination of references as set forth in the outstanding rejection is based upon hindsight reasoning.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the binding of a set of images (as taught by Stancato) into an album for protection and convenient access is knowledge generally available to one of ordinary skill in the art.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Art Unit: 2625

Appellant argues (10/15/04 Appeal Brief: page 23, line 23) that claims 54-56 are allowable because they depend from allowable parent claims.

Re the argument that these claims are allowable because they depend from an allowable parent claim, Appellant's arguments for the allowability of this parent claims have been addressed above.

Appellant argues (10/15/04 Appeal Brief: page 24, line 20 - page 25, line 2) that the Office Action fails to show any evidence in Klees or knowledge of those skilled in the art to provide a suggestion or motivation to modify the Fredlund reference so as to produce the claimed invention, and that the combination of references as set forth in the outstanding rejection is based upon hindsight reasoning.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). In this case, the ordering of picture prints from a public terminal (as taught by Klees) in order to enable such orders to be placed by customers who lack personal terminals is knowledge generally available to one of ordinary skill in the art.

Appellant argues (10/15/04 Appeal Brief: page 24, line 28) that claims 127-131 are allowable because they depend from allowable independent claims.

However, claim 127 is independent, and claims 128-131 depend therefrom. It is thus unclear what "allowable independent claims" Appellant is referencing in this argument.

Appellant argues (10/15/04 Appeal Brief: page 24, line 29 - page 25, line 11) that the Office Action fails to show any evidence in Cok or Klees or knowledge of those skilled in the art to provide a suggestion or motivation to modify the Fredlund reference so as to produce the claimed invention.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 2625

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the ordering of picture prints from a public terminal (as taught by Klees) in order to enable such orders to be placed by customers who lack personal terminals and the distribution of the order in the form of a computer-readable medium in order to supply the ordered images in the customer's preferred format (as taught by Cok) is knowledge generally available to one of ordinary skill in the art.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Stephen Brinich

Conferees:

Stephen Brinich *Stephen Brinich*

David Moore

Twyler Lamb

*Twyler Lamb*

*David Moore*

DAVID MOORE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800